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EXAMINER	
BROOKS, MATTHEW L	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN THOMAS BLOCHER, DEBORAH JEAN GURSKI,
and MEL B. LOMBARDO

Appeal 2009-000518
Application 09/884,095
Technology Center 3600

Decided: [1]July 29, 2009

Before, MURRIEL E. CRAWFORD, HUBERT C. LORIN and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1, 2, 4-30. We have jurisdiction under 35 U.S.C. § 6(b). (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellants claim a system and method for reviewing business processes, wherein control point information pertaining to the business processes can be arranged in a standard format on a template (Spec. 1: 6-8).

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A computer implemented method for reviewing a business process to identify and address risks, comprising the steps of:

providing a business process; identifying risks in the business process as control points; and arranging information pertaining to the control points in a standard format using a separate template for each control point and storing the template in a computer database to provide subsequent access to the template, wherein the information comprises a set of tests to be performed by a test entity, and wherein the set of tests identify an occurrence of the risks in the business process.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Pram It or Walk Away, *Neal S. Gary,* Transaction of AACE International; pp. r5-48; 1998

www.keane.com, Archive.org snap shot of, 05/20/2000

The following rejection is before us for review.

The Examiner rejected claims 1-2 and 4-30 as unpatentable under 35 U.S.C. § 103(a) over the PRAM.

ISSUES

Have Appellants shown that the Examiner erred in rejecting claims 1, 2, 4-30 on appeal as being unpatentable under 35 U.S.C. § 103(a) over PRAM on the grounds that a person with ordinary skill in the art would understand 1. to make separate templates of common and specific nature risks because a more specific risk which is not categorized as common would need to be made separate from the otherwise common risks and hence be listed on a template separate from the common risks; and 2. whether a person with ordinary skill in the art would understand that the manifestation of a potential risk is an occurrence of the risk.

PRINCIPLES OF LAW

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in

evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. Appellants' Specification does not specifically define the term risk, nor does it utilize the term contrary to its customary meaning.

2. The ordinary and customary definition of risk is 1: possibility of loss or injury. (http://www.merriam-webster.com/dictionary/risk).

3. PRAM discloses using a template to define control points or risks stating "If you have access to a template of common risks (see figure 1), read through it and mark any that apply to your situation. If there isn't a template, begin making one on that the next time you, or someone else, needs to identify risks, you won't have to start form scratch." (PRAM, p. 2. 2).

4. PRAM discloses encouraging

> … our branches to make risk templates common to their customer base. There are often some risks that are specific to a customer and many others of a more general nature. Think of risks to budget, schedules, quality, and scope. Some risks will affect more than one area. There are those risks that are within the control of the development team. There are those risks that are within entire control of the customer organization. Some risks are totally external to either group and therefore not

> controllable by either. All categories of risk should be identified at this point. (PRAM, p. 2. 2).

5. PRAM discloses that

> [o]nce the initial estimates exist, the estimator must make a list of risks for the task, project, job, or proposal that is being addressed. Listen for words and phrases including, That's an issue," "I don't know," We assume," "I'm not sure," "I think," "I have no idea," or "We'll figure it out as we go". These are a few tell-tale phrases that indicate the potential of risk. (PRAM, p. 2.2)

ANALYSIS

Initially, we note that the Appellants argue claim 1 as representative of independent claims 7, 10, 12, 16, 19,23,26, and 28. Thus, independent claims 7, 10, 12, 16, 19, 23, 26, and 28 stand or fall with claim 1.

Independent claim 1 requires *arranging information pertaining to the control points in a standard format using a separate template for each control point.*

Appellants argue that

> … the PRAM reference discloses a risk profile (Fig. 3) with all the key risks on one page. PRAM reference, page C, section V. As shown in Figure 3 of the PRAM reference, each risk variable (Stable Specs, SME's Available as Scheduled, etc.) is listed in the same profile/template. In contrast, the present invention claims, inter alia, a method for reviewing a business process that includes a separate template for each control point for arranging business process review information. (Appeal Br. 9)

We disagree with Appellants. Although Figure 3 of PRAM shows plural control points on a single template, we find that it is not outside of the disclosure of PRAM to provide separate templates for different risks which are presented by various populations. Specifically, PRAM discloses making "risk templates common to their customer base."(FF 3, 4). PRAM further discloses that "[t]here are often some risks that are specific to a customer and many others of a more general nature." (FF 4). We find here in PRAM an inference to make separate templates between risks of common and specific nature because a more specific risk, which is not categorized as common, would need to be made separate from the otherwise common risks and hence be listed on a template separate from the common risks. *See* KSR Int'l. Co. v. Teleflex Inc., 127 S.Ct. 1727, 1741 (2007) (In making the obviousness determination one "can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.")

Appellants next argue that "the PRAM reference does not disclose a template to identify whether the risk has actually occurred." (Appeal Br. 9). Appellants go on to assert that

> the PRAM reference discloses a method of risk identification based on verbal communication(s) between the customer and the estimator. Id. Depending on the words/phrases used by the customer, the risks are identified and listed in the template…. (Appeal Br. 10).

Appellants thus maintain that since PRAM discloses keying in on word/phrases, such as, "I don't know", or "I'm not sure" (FF 5), this only establishes potential risk and not the actual occurrence of a risk. (Appeal Br. 10). We disagree with Appellants. We find that Appellants' Specification does not specifically define the

term risk, nor does it utilize the term contrary to its customary meaning. (FF 1). The ordinary and customary definition of risk is 1: possibility of loss or injury. (FF 2). Thus, we do not find error with the Examiner's finding of a potential risk being an occurrence of the risk because the occurrence of a potential risk manifests when a person utters the words "I don't know."

Appellants do not provide a substantive argument as to the separate patentability of dependent claims 2, 4-6, 8-9, 11, 13-15, 17-18, 20-22, 24-25, 27, and 29-30, and thus these claims fall with the claims from which each depends.

CONCLUSIONS OF LAW

We conclude the Appellants have not shown that the Examiner erred in rejecting claims 1, 2 4-30.

DECISION

The decision of the Examiner to reject claims 1, 2, 4-30 is AFFIRMED.

AFFIRMED

JRG

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